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Application No.: 09/880,769

Docket No.: 60680-1647

REMARKS/ARGUMENTS

Applicant has carefully reviewed the Office Action mailed March 28, 2003 (paper no. 7). Applicant thanks Examiner Pickard for her detailed review of the pending claims. In response to the Office Action, Applicant has amended Figures 1 and 2 and amended claims 1, 8, and 19. No new claims have been added and no claims have been cancelled. By way of these amendments, no new matter has been added. Accordingly, claims 1-21 remain pending in this application. Applicant respectfully requests reconsideration of the present application in view of the above amendments and the following remarks.

Objection to the Drawings

Applicant notes Examiner's objection to the drawings that fail to show the varying distance between the metal ring and the metal layer. Corrected drawings are included with this response and the specification has been amended to include descriptions of these drawings. Specifically, Figure 1 has been amended to include the lines A-A' and B-B', which specify the sections along which the sectional views of Figures 2A and 2B are taken. Figure 2 is supplemented by Figures 2A and 2B. Figure 2A corresponds to the sectional view taken along line A-A'. In Figure 2B, a comparable sectional view is taken along the line B-B'. From these figures the varying distance between the metal ring and the metal layer become clear. Support for these amended drawings can be found on Page 2, paragraph 8 of the specification. The description states that "...an advantageous embodiment of the gasket is provided where the distance between the metal ring and the metal layer is variable along the circumference of the metal ring." Accordingly, the amended drawings that illustrate the variable distance between the metal ring and the metal layer do not constitute an introduction of new matter. In view of the correcting drawings, the Applicant requests removal of the objection.

Objection to the Specification

Examiner has objected to the specification for various informalities. These informalities have been corrected by amendments to the specification. Specifically, paragraphs 47, 50 and 52 have been amended to consistently describe "welding bead 7." The inconsistencies in the specification are the result of typographical errors during translation of the application from German to English. The Applicant believes all appropriate amendments have been made. Accordingly, the Applicant requests removal of the Examiner's objection.

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Claim Rejections Under 35 U.S.C. §112

Claims 1-15 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 1 and 8 to correct the improper antecedent basis with regard to "a welding bead." Specifically, in each claim, the second recitation of "a welding bead" has been corrected to read "said welding bead." The first recitation of "a welding bead" was added by the preliminary amendment and "a welding bead" from the original claims was not amended to clarify their relation. Accordingly, this amendment provides proper antecedent basis and the Applicant respectfully requests removal of this rejection as to claims 1-15.

Claim Rejections Under 35 U.S.C. §102(b)

Claims 1-3, 7-9, 13 and 14 were rejected under 35 U.S.C. §102(b) as being anticipated by Ueta (U.S. Patent No. 5,544,899). The Examiner argues that the Ueta patent discloses a gasket comprising at least one metal layer having a through-hole and at least one metal ring welded to the metal layer along a welding bead such that the layer and ring are in a spaced apart relationship.

In view of the amendments to independent claims 1 and 8, the Applicant respectfully traverses the rejection. While the Ueta patent does disclose a sublayer positioned between two base plates and welded thereto, the Ueta patent fails to disclose a gasket having a metal ring welded to a metal layer over a welding bead. The Ueta patent clearly illustrates that when welded together the sublayer planely lies on the base plate. In the present application only a small area of the welding bead is in contact with the metal ring and metal layer. The welding bead separates the ring and the layer to produce a more stable welding joint and improved sealing characteristics of the gasket. Accordingly, to further define this feature the Applicant has amended claims 1 and 8 to describe that the metal ring is welded to the metal layer over the welding bead. Therefore each feature of the independent claims is not shown in the Ueta patent and the claims are patentable.

Furthermore, claims 2-3, 7, 9, 13-14 are dependent claims adding additional limitations to the patentable independent claims 1 and 8. Again, because the Ueta patent fails to disclose each feature of the independent claims 1 and 8, the dependent claims are also patentable. Accordingly,

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the rejection is overcome and the Applicant respectfully requests allowance of claims 1-3, 7-9, 13 and 14.

Claim Rejections Under 35 U.S.C. §103

Claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka (U.S. Patent No. 5,690,342) in view of Opprecht (U.S. Patent No. 4,850,214).

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facie obviousness as follows: "To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The discussion with respect to the rejections under 35 U.S.C. §102 is equally applicable here. Moreover, with regard to claims 1-21 the Examiner has failed to establish prima facie obviousness because there is no suggestion or motivation to combine the teachings of the Tanaka and Opprecht patents. The Tanaka patent is directed toward a gasket that attaches a ring-shaped shim to a metal substrate by laser-welding. The Opprecht patent is directed toward a method of welding using a projection. The Tanaka patent does not suggest using any other technique for joining the shim to the substrate nor does the patent indicate a need for a strong, stable joint between the shim and the substrate. In the present application the welding bead places the metal ring and metal layer in a spaced apart relationship. As a result, a more stable welding joint is created along with improved sealing characteristics of the gasket.

Furthermore, the Examiner has failed to establish prima facie obviousness because the Tanaka patent in combination with the Opprecht patent fail to teach each limitation of the claimed invention. As argued above, the metal ring is welded to the metal layer over the welding bead. The Tanaka and Opprecht patents fail to show a ring and layer maintained in a spaced-apart relationship by the welding bead. The shim in the Tanaka patent is planely welded to the

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substrate and the Opprecht patent does not teach elements of a gasket separated by a welding bead.

Additionally, the Applicant believes that it would not have been obvious to one skilled in the art to combine the disclosures of the Tanaka and Opprecht patents. Opprecht is directed toward the art of resistance welding and more particularly toward fabrication of projections used with resistance welding. The present application is directed toward the art of metal gaskets. It would not have been obvious to one skilled in the art of metal gaskets to consider the disclosure of Opprecht since Opprecht does not relate to gaskets.

Finally, the present application discloses a gaskets that not only has a high quality connection and is easy and efficient to manufacture, but also has further advantageous properties. First, the ring-shaped shim in the Tanaka patent that is planely welded to the metal substrate functions as a distance limiter for a full-bead. In contrast, in the present application, the distance between the ring and the welding bead permits the ring not only to work as a distance limiter for the welding bead, but the combination of the welding bead and the ring works itself as a sealing element. Furthermore, the cranking in the Tanaka disclosure only provides limited elastic deformability. Meanwhile, the combination of the ring and welding bead in the present application provides a sealing unit with elastic and plastic deformability. (See Page 3, Paragraph 9 of the present application.) Thus, while the Tanaka patent requires a full-bead next to the combination of the cranking and ring-shaped shim to provide a sealing function, the welding bead and ring of the present application perform a sealing function without the addition of further sealing elements.

Therefore, because the Examiner has failed to show prima facie obviousness and for at least the reasons argued above, claims 1-21 are patentable. The Applicant respectfully requests removal of this rejection and allowance of the claims.

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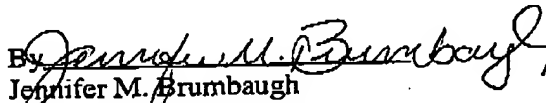
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC. If the Examiner has any question or comments, he is kindly urged to call the undersigned to facilitate prosecution.

Dated: June 30, 2003

Respectfully submitted,

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